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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,723	12/17/2001	Kenya Shitara	249-243	6052

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EXAMINER

GRUN, JAMES LESLIE

ART UNIT PAPER NUMBER

1641

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/009,723	Applicant(s) SHITARA ET AL.	
	Examiner James L Grun	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-65 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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In the examination of international applications filed under the Patent Cooperation Treaty, PCT Rule 13.1 states that the "international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ('requirement of unity of invention')".

5 The method for determining unity of invention under PCT Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

10 (1) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of said product, and an independent claim for a use of said product, or

 (2) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out said process, or

15 (3) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of said product, and an independent claim for an apparatus or means specifically designed for carrying out the process.

20 Unity of invention is fulfilled only when a group of inventions is linked in technical relationship by at least one corresponding technical feature (i.e. the inventions are not independent), wherein the corresponding technical feature(s)is(are) "special" under PCT Rule 13.2, i.e. a contribution over the prior art.

 This application contains inventions or groups of inventions which are not so linked as to form a single inventive concept. Under PCT Rule 13 the following combinations of claims of different categories are permissible and restriction to one of the following combinations is required:

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I. Claims 1-31, drawn to a given product (binding substance) and a process using said product (detection method).

II. Claims 1-10 and 21-42, drawn to a given product (binding substance) and a process using said product (diagnostic method).

5 III. Claims 43-65, drawn to a given product (signal transduction inhibitor).

The inventions listed as Groups I-III do not meet the requirements for Unity of Invention for the following reasons:

The groups of inventions are not linked by a corresponding "special" technical feature because of the possible divergent structures of the agents/reagents/substances as claimed and in
10 view of the disclosure in Shitara et al. (EP 0,882,799) of the particular monoclonal anti-VEGF receptor Flt-1 antibodies as instantly claimed.

Groups I and II, related each to the other, are independent and distinct methods of using the same or similar products which differ in design, performance, and function. There is also no provision in PCT Rule 13 for claims directed to multiple alternative uses of a given product in
15 the same international application.

Group III, as related to either of the inventions of Groups I or II, are drawn to distinct groups of products with particular functions which may include some of the same or similar binding substances. However, the products, as claimed, may also differ widely in structure, function, and use. The widely different product structures, or the similar monoclonal antibody

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structures common to the groups, are not a "special" technical feature which links the groups in technical relationship, as set forth above. Moreover, the different or similar products are claimed for different intended uses, and there is no provision in PCT Rule 13 for claims directed to multiple alternative uses of a given product in the same international application.

5

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

10

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Grun, Ph.D., whose telephone number is (571) 272-0821. The examiner can normally be reached on weekdays from 9 a.m. to 5 p.m.

5 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, SPE, can be contacted at (571) 272-0823.

The phone numbers for official facsimile transmitted communications to TC 1600, Group 1640, are (703) 872-9306.

10 Any inquiry of a general nature or relating to the status of this application, or requests to supply missing elements from Office communications, should be directed to the Group receptionist whose telephone number is (571) 272-1600.

JLG
James L. Grun, Ph.D.
July 12, 2004

Christopher L. Chin
CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP ~~1800~~ 1641
7/12/04